

ESTTA Tracking number: **ESTTA1034306**

Filing date: **02/07/2020**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91233690
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Submission	Motion for Summary Judgment Yes , the Filer previously made its initial disclosures pursuant to Trademark Rule 2.120(a); OR the motion for summary judgment is based on claim or issue preclusion, or lack of jurisdiction. The deadline for pretrial disclosures for the first testimony period as originally set or reset: 03/22/2020
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Attachments	Applicant Summary Judgment Motion NOLD UPLOAD.pdf(315005 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
TRADEMARK TRIAL AND APPEAL BOARD**

Image Ten, Inc.	Opposition No. 91233690
Opposer,	Serial No.: 87/090468
Vs.	APPLICANT - MOTION FOR SUMMARY JUDGMENT AND MEMORANDUM OF POINTS AND AUTHORITIES IN SUPPORT OF MOTION FOR SUMMARY JUDGMENT
Rusty Ralph Lemorande	
Applicant	

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INTRODUCTION

Opposer seeks to rise from a death of decades in order to claim it would be harmed by allowing Applicant to own a trademark in the phrase “NIGHT OF THE LIVING DEAD” for motion film production. Opposer claims that it has common law rights dating back to 1968 based on the release of a movie with the same name. Whether Opposer has rights in a mark based on the 1968 movie is far from established. However, whether or not Opposer can claim rights in 1968 is irrelevant as Opposer ceased to be an entity in 1969. When the Opposition was filed in March of 2017, Image 10 was a defunct entity that had been defunct for almost a half of a century. It wasn't until May of 2017 – two months later -that Image 10 filed for revival of the business entity. Image 10 cannot produce any records to show it conducted any business from 1969 through 2017, cannot produce records of any movie production in that near half-century timeframe, cannot produce any evidence of policing its common law rights in that timeframe, and cannot produce any evidence it maintained any business of any kind despite its corporate death in 1969. .

A Summary Judgement motion relies on the well-grounded proposition that there are no disputed matters of fact, and judgement can be made as a matter of law. There are no disputed matters of fact in this matter, and judgment can be made as a matter of law by the TTAB.

In short, this Summary Judgment will detail that:

1. Opposer Lacks Standing - You Can't Be Harmed If You Don't Validly Exist
2. Assuming all evidence presented by Opposer is valid, Opposer has no:
 - a. evidence or claim of use beyond the 1968 movie,
 - b. no evidence of use for film production other than the 1968 movie,

- c. no evidence of policing its claimed common law mark,
- d. no evidence of commercial activity.

With no commercial activity, there can be no marketplace recognition since Opposer isn't in any market, and certainly not with the Class applied-for by Applicant.

BACKGROUND

The TTAB is well aware of the nearly three-year history of this opposition proceeding. Applicant will merely briefly summarize.

After the TTAB examiner deemed the ITU application suitable for publication, an opposition was timely filed.

What has ensued since is a history of obfuscation, change of counsel, untimely submissions by Opposer, requests for Applicant to deal directly with a non-lawyer representative of Opposer, and other dilatory and evasive actions which have seriously prejudiced Applicant's legal and bona fide business intentions (for which the ITU procedure was created) costing both Applicant and the TTAB unnecessary expenditures of resources, time and, in some instances, money.

Most recently, after several months at attempts to settle the matter with a member of Image Ten (requesting noninvolvement of its counsel) in an 11th hour move, counsel, quickly reengaged, reversed the long-in-negotiation settlement agreement. Therefore, in order to avoid further losses and time wasted, Applicant now files this Summary Judgment motion.

PRELIMINARY ARGUMENTS

Applicant makes the following preliminary arguments for Summary Judgment.

Opposer's sole evidence in their claim of common law trademark protection is a series of newspaper and magazine clippings, extolling the memorable qualities of the 1968 film, such publicity largely derived from infrequent film conference attendance and installations comprised of small, rented booths in which merchandise can be vended and some face-to-face encounters with the actors and filmmakers occasionally might occur.

None of this is relevant to the ITU application at issue given the intended class is for the production of motion pictures, not the conducting of publicity events for an extant motion picture.

Opposer's own Summary Judgement motion, untimely filed with the TTAB and rejected by the TTAB as untimely soon thereafter, is arguably sufficient evidence for this motion for it proves Opposer has no relevant or substantive evidence. Given the untimely motion was one for summary judgment, intended to dispose of the matter completely providing Opposer's 'best shot' at resolution, the absence of any dispositive or relevant evidence is telling. Other than a few newspaper ads from 1968, and a long list of interviews given by certain filmmakers (and not, for the record, Image Ten, the actual Opposer) no other evidence is provided in Opposer's SJ Motion.

AS TO PRIOR CLAIMS OF PRIVILEGED INFORMATION

Opposer, in its repeated attempts to block discovery, causing motion repeated practice which consumed considerable time and resources of both the TTAB and Applicant, often made claims of confidential business information not available to Applicant in his defense of the Opposition caused by Image Ten.¹ Opposer's prior, untimely submitted Summary Judgement

¹ If the information is confidential and not to be seen by others, then it cannot now be disclosed in Opposition trial documents soon to be available not only to Applicant but to the public.

motion itself proves there was no such information - that, in fact, Image Ten, since its short life in 1968, has not only disappeared, terminated by its own election, but other than hobbyist-like activity, has conducted virtually no business and none in conflict with Applicant's stated intentions.

OPPOSER LACKS STANDING AS IT DID NOT EXIST AS A VALID ENTITY WHEN IT INITIATED ITS OPPOSITION PROCEEDING

Arguably, Image Ten had no standing to even oppose applicant's filing since Image Ten did not exist at the time of Applicant's filing. It is undisputed that Opposer was formed in 1968 in Pennsylvania and became defunct approximately one year later in 1969. It is also undisputed that the Opposer filed this action on March 29, 2017. It attempted to raise the defunct corporation from the dead by filing for revival in Pennsylvania on May 2, 2017 about two months after the filing of its Opposition. Therefore, on March 29, 2017, Opposer was not a valid entity and thus could not suffer any harm as it didn't exist.

Perhaps, in the fantasy world of horror fiction, a company can die and then, zombie-like, rise from the dead to assert imagined, dreamed-of business activity over the prior half century. But, like Rip Van Winkle, time waits for no one. The consuming public for whom Trademark protection primarily exists, did not sleep along with Image Ten for nearly a half century, and Applicant, a business person who did not slumber and whose interests are also protected by Federal trademark law, also should not be expected to confront newly risen ghosts objecting to his pursuit of bona fide business plans and activities.

THE NON- TRADEMARK EFFECT OF POST HOC PUBLICITY INTERVIEWS.

OPPOSER CONFUSES PUBLICITY WITH PRODUCTION (OF MOTION PICTURES)

A principal support argued by Opposer for its assertions of trademark use is a series of interviews occurring since the creation of the film.

Opposer confuses publicity with the policing of a trademark.

Applicant himself, a filmmaker, has given numerous interviews, in many media, over nearly the past 40 years, pertaining to various motion pictures in which he has served as a writer, producer, director and even actor. (See Affidavit, Exhibit 1)

It would be folly - a chimera - for Applicant to suggest that such publicity established a trademark in the relevant films by mere virtue of the existence of these interviews and the resulting media broadcasts, recordings and print articles.

Woody Allen, for example, has been a writer/producer/actor and/or director in over sixty seven films. There are no trademark registrations granted to Mr. Allen for any of these films. A Lexis-Nexus search fails to reveal any legal actions, state or Federal, claiming common law trademarks for his films.

A CONFUSION OF DISTRIBUTION VS. PRODUCTION

Perhaps the inappropriate Opposition proceeding, previously submitted by Image Ten, is the result of that party's failing to make the critical distinction between the production of one motion picture then licensed to a third-party distribution company. Perhaps the confusion continues in Opposition's argument in favor of trademarks through its promotional acts at film conventions. At best, such action would constitute distribution. Applicant is seeking a mark for production, not distribution.

TRADEMARK REGISTRATION IS NOT AVAILABLE FOR ONE MOTION PICTURE TITLE

Opposer has made one motion picture solely Followed by its self-termination approximately one year later. Opposer's arguments for trademark rights, common law or otherwise, fail given trademark rights cannot inure to one motion picture. Even if Image Ten claims that the publication of reissues or enhanced versions of the original film is evidence of production it is a misplaced argument. 'Motion picture production' has plain meaning. Mere licenses of the prior title or reissues, colorized and higher resolution versions do not fall into the category of 'motion picture production'. If the newly born Image Ten corporation, risen months after Applicant's ITU filing and even Image Ten's Opposition, intends to manufacture motion pictures going forward utilizing the mark, then its proper task is to file an ITU with the USPTO which application, of course, would likely fail given its untimeliness.

AN EXAMINER'S APPROVAL FOR PUBLICATION CREATES A REBUTTABLE PRESUMPTION, WITH THE BURDEN FALLING ON THE OPPOSER

Image Ten, as Opposer, must meet its burden in order to cause the USPTO to reverse its examiner's initial decision. Based on the lack of evidence, clear history of entity termination, and lack of policing of any kind, Image Ten cannot meet this burden.

AS TO A CLAIM OF COMMON LAW TRADEMARK RIGHTS IN TEE SHIRT AND TOY SALES

Although Opposer asserts evidence of marks on toys, tee shirts, and similar in the marketplace in some kind of support of its Opposition, it is irrelevant for several reasons. The most dispositive is that Applicant has not sought a trademark for toys or tee-shirts. Secondly,

Opposer's recent acquisition of a prior existing, registered mark for toys has no bearing on the instant matter given, again, that toys are not at issue. Furthermore, the acquisition of a prior registered mark for toys from a bona fide entity with ongoing market involvement,² by Image Ten, seems to be, at least partly if not fully, merely an attempt to bolster its argument relying on a theory that the post hoc purchase of a previously registered mark somehow imputes prior, common law rights.

This is illogical, contrary to law, and again, suggests, an attempt to raise something from the dead that never died in the first place because it never existed (i.e. common law trademark rights in toys).

Applicant is a filmmaker, not a toymaker, nor a tee-shirt maker.

In short, Applicant asserts that this 11th owner transfer of a trademark for toys, does not in any way conflict with Applicant's properly filed application for Motion Picture production. The assertion that this acquisition (recent) of a trademark for toys should relate-back to a 50-year absence of registration of policing by Image 10, is a specter, and should be ignored by the TTAB.

AS TO THE SALE OF POST HOC FILM MEMORABILIA

Almost all motion pictures generate memorabilia of some type - props, signed scripts, posters, costumes, etc. Depending on the success of a film, such memorabilia becomes available for sale or resale indefinitely after the initial marketing and release of a film, or ends up in dumpsters and landfills.

² A company known as SphereWerx

Opposer has, in fact, provided evidence of some sales of related memorabilia. However, Opposer dissembles in its argument that occasional sales of such items constitute a continuing market for the production of new motion pictures.

In addition, Opposer's failure to provide any evidence of such sales (either through invoices, billings, financial records, tax returns, etc.) belies the fact that very little occurred. In addition, if some level of commerce occurred, it was not conducted as a professional business, but merely by personal operation - a kind of 'hobbyist form of business. Again, given that Image Ten dissolved shortly after its birth in 1968 obviates any claim by Opposer that such spurious sales represent the kind of activity and policing required to argue common law trademark rights. (Since no entity existed over the nearly past century, no tax returns exist to indicate proper and legal IRS practices in the vending of this merchandise. If such is the case, Applicant respectfully argues that the TTAB should not reward Opposer for its unclean hands, zombie or otherwise

AS TO FILM CONVENTIONS

Applicant, himself, has participated in film festivals and conventions over the past decades, commemorating his contribution to some films of significance (e.g. *Caddyshack*, *Yentl*, and Michael Jackson's *Captain Eo* amongst others).

Such participation would never be submitted as proof of an on-going business (in the production of motion pictures) but as a pleasant contribution to the public's interest in such film product.

Applicant has, from time to time, been asked to autograph items. He has done so without a fee. It appears Opposer has received remuneration for such autographs. If so, it is not part of a business whose operation (including facilities, machinery, offices and personnel) is the production of new motion pictures. It is merely personal revenue to the signers (such as invited

actors), many of whom are not even owners of the original Image Ten or its recently revived version.

FAILURE TO POLICE CREATES A PRESUMPTION OF ABANDONMENT

It is well-settled law that a failure to police and, therefore, preserve rights in a trademark - whether one acquired by common law or Federal registration - creates a presumption of abandonment. In *Five Platters, Inc. v Purdie*, the plaintiff, The Platters, a widely recognized performing group, sought protection of its trademark, arguing that although used by others, there was sufficient policing through warnings, negotiations, threats and numerous lawsuits. Opposer, other than by its 11th hour opposition filing, has conducted none of these methods of policing over the course of nearly a half century

The Five Platters court, in its decision, stated:

The defendants' contentions that plaintiff has lost any rights it had in the words "The Platters" because of uncontrolled use of the name by others and because the name has become generic is likewise unavailing. The evidence showed that plaintiff has been vigilant and determined in efforts to police and preserve the rights it conceives it has in the name "The Platters." It has sought through warnings, negotiations, threats, and numerous lawsuits to preserve and to protect the name. [Emphasis added]. *Five Platters, Inc. v. Purdie*, 419 F. Supp. 372

See also *McKeeson & Robbins v. Charles H. Phillips Chemical Co.* (1931, CCA2d Conn) 53 F2d) in which plaintiff brought an action to cancel the registration of the trademark "Milk of Magnesia," which had been registered in 1905. The court stated clearly that:

The failure of the defendant during a long period to assert or enforce its rights and its essential disregard of the trademark is proof of an intent to abandon.

RIGHTS FOR SUBSEQUENT USER AFTER ABANDONMENT

A logical question now arises-as to the rights of a new user to an abandoned trademark. This matter is put to rest by several cases. See, for example, *Pelonis USA, Ltd. V. Del-Rain Corp* (U.S. District Court of the Western District of New York) in which the court stated:

A determination that a mark has been abandoned defeats the alleged owner's claim of priority: Once abandoned, the market reverts back to the public domain whereupon it may be appropriated by anyone who adopts the mark for his or her own use. Hence, a party that is found to have abandoned its mark is deprived of any claim to priority in the mark before the date of abandonment..." [Emphasis added]

The Pelonis court also found that a particular burden falls upon the prior user (in the instant case, that is Opposer although, as stated opposer has never been in the business of producing more than one film). In such cases:

W]here the statutory presumption of abandonment has been established by non-use, the trademark owner must demonstrate that circumstances do not justify the inference of an intent not to resume use." [Emphasis added.]

See also *Playboy Enters. v. P.K. Sorren Exp. Co.*, (546 F. Supp. 987) in which the court found that courts have often held that the owner of a mark was estopped from enforcing the mark when it took no action for an unreasonable period of time after learning of an infringing use.

In the Opposition now before the TTAB, Applicant argues that nearly a half century is an unreasonable amount of time. Actually, in many of these cases, a matter of 3 years or less have been found unreasonable.

Specifically, in *Playboy*, the court stated that:

Under trademark law, while a party who has abandoned its trademark rights cannot revive those rights by resumed use, resumed use does establish a second priority date for rights to the trademark as a matter of law.

...With regard to priority of use after abandonment, it has long been established that the mere fact of seniority alone does not entitle the first user of a trademark to superior rights in the mark" [Emphasis added].

APPLICANT'S GOOD FAITH AND PROPER EFFORTS IN HIS I.T.U. PROCEEDINGS

Applicant diligently researched the title before filing his registration request.

The Trademark Office, thereafter, conducted its own research and, as a result, approved Applicant's ITU application for publication. Therefore, by Trademark rules, there is a presumption in Applicant's favor, and it is up to any opposer to meet the burden of proof showing that a Notice Of Allowance should not be granted.

Opposer has not met this burden.

AS TO THE NEXUS WITH COPYRIGHT LAW FOR A SOLE, MOTION PICTURE

In the realm of copyright, many copyrighted works have lost protection because of technical recording errors, notice failures or other errors pertaining to legal requirements occasioned by original claimants. There is no wiggle room for such errors; apologies aren't sufficient for restoration.

As much regret as Image Ten may feel (as the original authors of the film) in not protecting their copyright or their trademark, the law does not allow special exceptions.

It is well recognized in the library of horror films that *The Night Of The Living Dead* has been in the public domain almost since its release in 1968. Therefore, it can no longer rise from the dead and be granted an afterlife either in copyright or trademark (if the latter right ever existed).

Since 1968, the date of creation of *The Night Of The Living Dead*, more than 149 derivative works (including remakes, sequels and prequels) have been created and introduced to the public marketplace.

Opposer has made no copyright claims against these titles because it knows it cannot.

It would seem that Opposer is now attempting to use trademark law to supplant copyright. That, obviously, violates the rules of trademark law and its well-known purpose.

AS TO “ANALOGOUS USE”

Opposer’s arguments seem to imply that publicity efforts including attendance at film conferences, and even its recently acquired (through business transfer) or a prior party’s registered trademark for toys, can be applied as analogous proof of its business efforts over the past near century. (Again, it should be reiterated that Opposer has not existed for nearly the entirety of those near-50 years and, therefore, lacked standing to even initiate an Opposition. This is perhaps the most dispositive aspect of this motion for Summary Judgment.

As to the theory of analogous use, a prior TTAB opposition well references the TTAB position and its relevance to the instant matter. In Opposition Nos. 91168152 91170940 *Westrex Corporation v. New Sensor Corporation* (as consolidated) the TTAB first points out that:

...a party may rely upon pre-sale activities in order to "tack on" non-trademark usage for purposes of establishing priority under Section 2(d) quoting 3 *J. Thomas McCarthy on Trademarks and Unfair Competition*, § 20:16 (4th Ed. 1996).

The decision then goes on to state, however, that analogous use must be more than mere advertising. Citing *In T.A.B. Systems v. PacTel Teletrac*, 37 USPQ2d at 1882, where the Appeals Court for the Federal Circuit summarized the test for the sufficiency of analogous use efforts:

"[W]hether it was sufficiently clear, widespread and repetitive to create the required association in the minds of the potential purchasers between the mark as an indicator of a particular source.

Per the TTAB's decision:

...for purposes of establishing priority via analogous trademark use, the critical factor is the actual number of prospective customers reached.

It then specifically analyzes the 'paucity' of inquiries between customers and seller indicating a significant impact on the purchasing public as a whole stating that 'perception must involve more than an insubstantial number of potential customers'.

An actual mathematical model is then stated:

For example, if the potential market for a given service were 10,000 persons, then advertising shown to have reached only 20 or 30 people as a matter of law could not suffice. However, close the linkage between the mark and the future service, analogous use could not be shown on such facts because the actual number of potential customers reached, not the strength of the linkage for some "reasonable potential customer," is the focal point of the analogous use inquiry.

The potential market for a horror motion picture in the United States can be logically and rationally asserted as the population over the age of 18. That represents 77.6% of the population per the latest U.S. Census data (July 1, 2019), equaling 77.6% of 328,239,523 or a total of over twenty-nine million people annually.³ Although Opposer has not provided a number describing the quantity of people in the U.S. to whom it markets its prior relation to the film at local film conferences, logic alone makes clear that the test stated above is not met in any form.

RE TOKEN USE

³ Applicant would ask that the TTAB take judicial notice of the U.S. Government census data, and the simple percentage math applied.

In the above decision, the TTAB discusses the concept of ‘token use’. Opposer’s limited sales of posters, memorabilia, autographs and the like and regional and infrequent film conference events seems to be clearly ‘token use’ of any mark Opposer might claim.

The tribunal speaks to this matter in its decision, especially as it relates to the legislative intent when creating the ITU procedure (highly relevant in the instant matter):

It is readily apparent that the constructive use provision of §7(c) of the Lanham Act, as amended, was intended to foster the filing of intent-to-use applications. By according conditional rights to those who publicly disclose their marks, constructive use encourages the early filing of applications and the searching of trademark records prior to the adoption of and investment in new marks...

Thus, a mere token sale or shipment of the goods does not constitute “use” under the Trademark Act. [Emphasis added] See *Paramount Pictures Corp. v. White*, 31 USPQ2d 1768, 1774 (TTAB 1994) and *H.R. Rep. No. 100- 515*, 100th Congress, 2d Sess.

Based on the above, it seems clear that Opposer’s claim of occasional sales of memorabilia, not of new motion pictures but the sole motion picture created in 1968 by a corporation defunct within the subsequent two years, does not constitute use of any kind. Therefore, the theory of analogous use fails as an argument in support of Opposer’s claims; in addition, any token use by Image Ten does not rise to a protectible interest.

CONCLUSION

Image Ten’s opposition fails for a variety of reasons. In addition, there are no disputed facts in this matter, therefore the TTAB may adjudicate the opposition as a matter of law through a Summary Judgment motion.

In short, Opposer’s action fails due to the following:

1. Opposer Lacks Standing – A party can't be harmed if it does not legally or validly exist.
2. Assuming all evidence presented by Opposer is valid, Opposer has no:
 - a. evidence or claim of use beyond the 1968 movie,
 - b. no evidence of use for film production other than the 1968 movie,
 - c. no evidence of policing its claimed common law mark,
 - d. no evidence of commercial activity.
3. In addition, the evidence is clear that Opposer abandoned its mark.
4. Applicant's application is for film production. Other than one film, Opposer has not been a motion picture production company.
5. Any theory of analogous use fails
6. Opposer's use is, at best, defined as token. Such use cannot be considered as 'use' under the Trademark Act.

Accordingly, Applicant respectfully submits that the Application to register NIGHT OF THE LIVING DEAD should be approved and provided with a Notice of Allowance.

Dated February 6, 2020

Respectfully Submitted

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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing was sent to attorneys for Opposer in addition to the manager of Image Ten who asked to be communicated with directly in this Opposition, on this 6th Day of February 2020, via email to the following:

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